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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/602,188

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James Demetrios G. Arquette

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DALE F. REGELMAN

QUARLES & BRADY, LLP

ONE SOUTH CHURCH AVENUE AVE, STE. 1700

TUCSON, AZ 85701-1621

EXAMINER

WESTERBERG, NISSA M

ART UNIT

PAPER NUMBER

1618

NOTIFICATION DATE

DELIVERY MODE

04/08/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

dregelma@quarles.com

rmendez@quarles.com

Office Action Summary

Application No.

10/602,188

Applicant(s)

ARQUETTE, JAMES DEMETRIOS G.

Examiner

Nissa M. Westerberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 8, 12 - 16 is/are pending in the application.
- 4a) Of the above claim(s) 3, 4, 8, 13 - 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5 - 7, 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicants' arguments, filed February 12, 2008, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claim Rejections - 35 USC § 102

1. Claims 1, 2, 5 – 7 and 9 – 12 were rejected under 35 U.S.C. 102(e) as being anticipated by Bassi et al (US Patent 6,982,164). This rejection is WITHDRAWN.
2. Applicant's arguments with respect to claims 1, 2, 5 – 7, and 9 – 12 have been considered but are moot in view of the new ground(s) of rejection. Those arguments that are applicable to Bassi et al. as it is applied in the new grounds of rejection put forth below are addressed in the new grounds of rejection.

New Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1, 2, 5 – 7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bassi et al (US Patent 6,982,164) in view of Tang et al. (US Patent 6,620,442).

As discussed in the Office Action mailed August 13, 2007 and in the response by Applicant filed February 12, 2008, Bassi et al. discloses compositions that comprise titanium dioxide, hydrolyzed jojoba protein and hydrolyzed jojoba amino acid (col 16, ln 24 – 31). Both of these products contain simmondsin (col 8, ln 54 – 62). The use of products containing high levels of simmondsin in the jojoba protein extracts in cosmetic products, such as sunscreens, is the concern of the invention disclosed in Bassi et al. (col 1, ln 8 – 18).

The hydrolyzed jojoba protein and hydrolyzed amino acid are obtained from jojoba meal that is not extracted with 100% ethanol as in the amended claims but rather through extraction with aqueous solutions (water in example 1, col 5, ln 29 onward and by an alkaline aqueous solution in example 2 (col 6, ln 20 onward)).

Tang et al. discloses that when jojoba meal is extracted with 95% ethanol to produce a crude extract (example 1, col 7, ln 50 – 57), the crude extract contains simmondsin that was further concentrated using activated carbon (col 7, ln 65 – col 8, ln 24). Variations in the polarity of an extraction media is a results effective parameter as changes in solvent composition and polarity alter the compounds and amounts of those compounds which are extracted. Optimization of result effective parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ and reasonably would expect success. Therefore it would have been obvious to prepare an extract of jojoba meal using 100% ethanol when the prior art teaches extraction using 95% ethanol.

Applicant argues that extraction of the jojoba meal with 100% ethanol will not result in the extraction of jojoba protein (p 6, paragraph 2). “Jojoba protein” is not a single protein but rather refers to the mixture of proteins that is found in jojoba. While many folded proteins are hydrophilic in nature, folded membrane proteins, for example, are hydrophobic. Exposure of the hydrophobic amino acid residues generally present in the core of soluble proteins, through a process such as denaturation, can also result in proteins that could be extracted by a less polar solvent than water such as ethanol. Applicant has not provided any evidence that no proteins or amino acids are present in the 100% ethanol extract of jojoba meal but merely argues that no proteins are extracted from jojoba meal by 100% ethanol. As this argument is not supported by facts, it is a mere allegation and it is not persuasive.

The aqueous and ethanol extracts of jojoba meal contain the same ingredients, although the relative amounts of those ingredients may be different. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted) **MPEP 2113**. The claims of the instant application do not recite limitations as to the ingredients and/or amounts of those ingredients present in the extract from jojoba meal. The examiner has provided sufficient evidence to shift the burden to applicant to provide evidence that the jojoba meal extracts of the prior art and the claims of the instant invention, and thus the topical compositions comprising such extracts, are materially different. See *In re Best*, 195 USPQ 430 (CCPA 1977) and *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980).

It would have been obvious to one of ordinary skill to use an ethanolic extraction method of jojoba meal, as taught by Tang et al., to prepare a jojoba extract that is used in the topical composition as taught by Bassi et al. There is no difference that the different extraction processes result in a materially different product.

Double Patenting

6. Claim 1 was rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,029,709.

This rejection is traversed on the basis that the amendments to the claims of the instant application to recite a jojoba extract formed by extracting jojoba meal with 100% ethanol patentably distinguishes claim 1 of the instant application from claim 1 of '709.

These arguments are not found to be persuasive as the claim of US Patent '709 recites a composition comprising an aqueous extract of jojoba meal. As discussed above in more detail, Applicant has not presented evidence that an aqueous extract and a 100% ethanol extract of jojoba meal result in materially different products. Arguments without factual support are mere allegations and are not found to be persuasive. Therefore, this rejection is MAINTAINED.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nissa M. Westerberg whose telephone number is (571)270-3532. The examiner can normally be reached on M - F, 8:00 a.m. - 4 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael G. Hartley/
Supervisory Patent Examiner, Art Unit 1618

NMW